IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:	) Date: September 2, 2008
Bradley R. Hammell	) Attorney Docket No.: F-759
Serial No.: 10/722,231	) Customer No.: 00919
Filed: November 25, 2003	) Group Art Unit: 4137
Confirmation No.: 6693	) Examiner: OBEID, Fahd A.

Title: Method for Providing a Shortcut to Shipping Information

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 1-20 of the above-identified application mailed March 31, 2008. This Brief is in furtherance of the Notice of Appeal transmitted in this case on June 30, 2008. Accordingly, this brief is timely filed. The fee for submitting this Brief is $510.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of $510.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. **16-1885**.

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellant, his legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-20 are in the case and under final rejection of the Examiner.

Claims 1-3 and 5-20 are in the case and stand finally rejected under 35 U.S.C. 102(b) as allegedly anticipated by US Patent Application Publication No. 2002/0032573 by Williams, et al. ("Williams '573").

Claim 4 is in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by US Patent Application Publication No. 2002/0032573 by Williams, et al. ("Williams '573") in view of US Patent No. 6,965,868 to Bednarek ("Bednarek '868").

Appellant hereby appeals the final rejection of claims 1-20.

IV. Status of Amendments

No Amendments have been filed subsequently to the Final Office Action of March 31, 2008 ("Final Rejection"). Therefore, the claims set forth in Appendix A to this brief are those as pending prior to the Final Rejection.

V. Summary of Claimed Subject Matter

Appellant's invention as presently claimed relates generally to new and useful systems and methods for enabling a user to check and verify shipping status. In one illustrative example, a merchant or carrier formulates a small html page that is capable of redirecting the user to the carrier's web site with the query and tracking identifier

already entered. The user is then given the option to save this small html page on the user's desktop or other local storage area. From then on, the user just selects that icon and current shipping information is displayed without any need for the user to memorize a tracking identifier or spend time authenticating. Carriers may typically provide delivery status at discrete checkpoints such as source and destination or for example, discrete checkpoints A, B, C, D, and E. Here, the system allows the user to find out where the item is between, for example, points A and B or between points B and C. The user may be provided one free access to the system, and then charged for further deluxe pinpoint tracking information. See Specification at ¶¶ 0004-7 and FIGs. 1-4.

In FIG. 3, system 300 illustrates the difference between pinpoint and checkpoint symbols. The user's computer 310 displays a shipment pinpoint symbol 315 and a shipment checkpoint symbol 320. They may be displayed at the user's desktop or other clickable item. If the user select pinpoint symbol 315, the carrier determines where the shipment is located between checkpoints. The carrier does this by using a shipment location tracker device 322 for contacting a delivery vehicle 324, so that the delivery vehicle will report its position, for example, by using a GPS unit. See Specification at ¶ 0024 and FIG. 3.

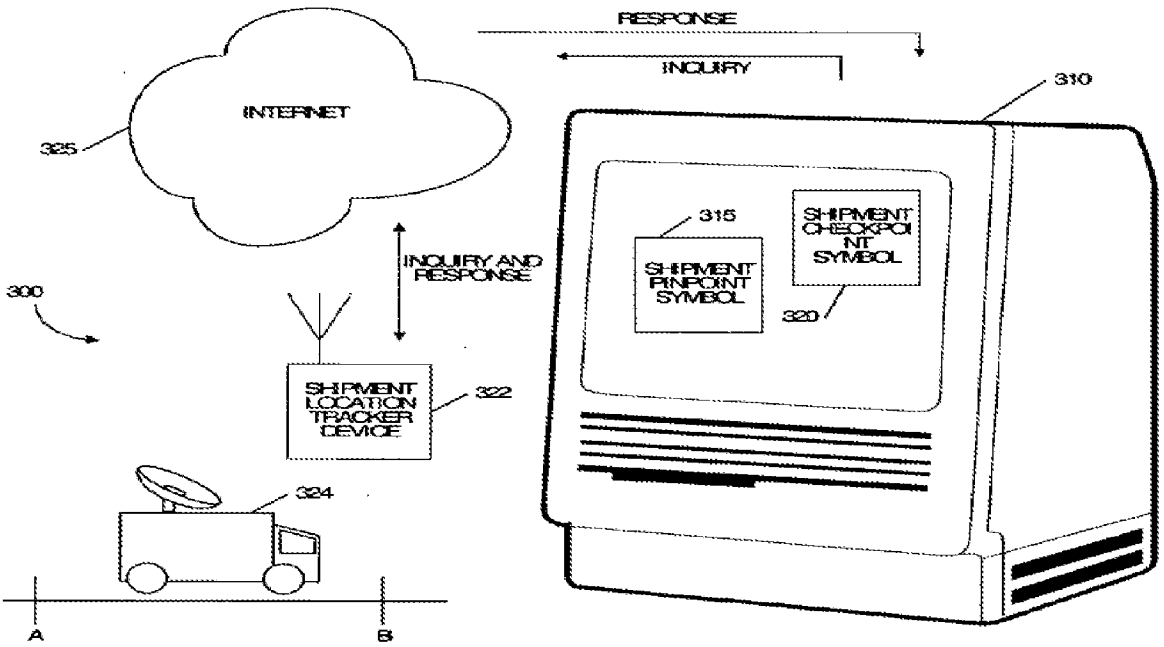

FIG. 3

In FIG. 1, a user is provided 100 with a shipping pinpoint symbol and a shipping checkpoint symbol. These may be icons on the user's desktop.

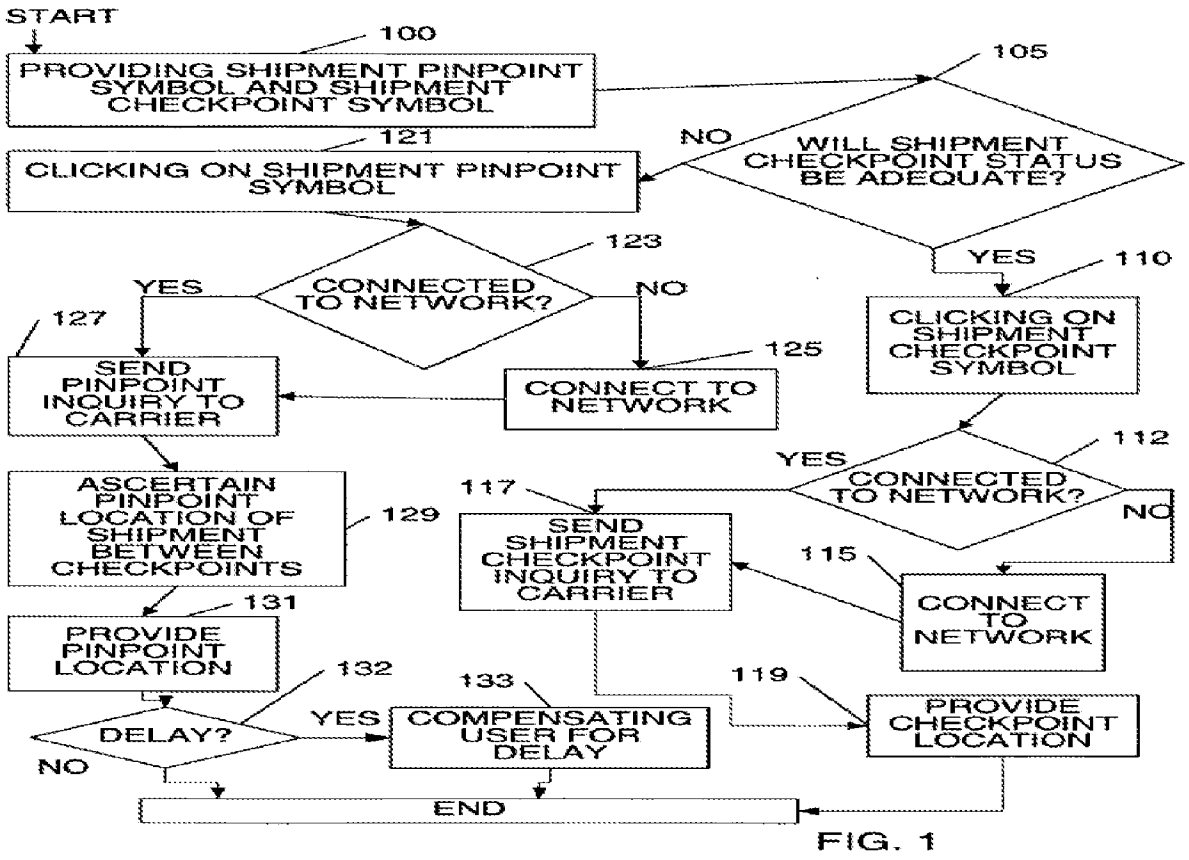

FIG. 1

The user decides 105 whether checkpoint status will be adequate or whether pinpoint status is required. If checkpoint status is sufficient, then the user clicks 110 on the checkpoint symbol. A checkpoint inquiry is sent 117 to the shipping carrier, and the carrier provides a checkpoint location to the user. Subsequently, the user is able to repeat this procedure. If, at step 105, the user decides that more precise shipping status is desired, then the user clicks 121 on the shipment pinpoint symbol which may be available on the user's desktop or in a folder in the user's computer, or additionally may be available at a carrier's web site that has been accessed by previously having clicked 110 on the shipment checkpoint symbol. A pinpoint inquiry is sent 127 to the carrier. In response to that inquiry, the carrier ascertains 129 a pinpoint location of the shipment between checkpoints. This may be done, for example, by communicating with

a delivery truck or airplane which is equipped with a global positioning satellite (GPS) device, and then the carrier can plot the GPS coordinates on a map and present 131 the map to the user. If 132 the user is provided with the pinpoint location after a delay, then the user can be compensated 133 for the delay, for example by providing the user with a monetary credit, or by providing the user with a free pinpoint click in the future. See Specification at ¶¶ 0020-22 and FIG. 1.

In FIG. 2, user 200 performs a purchase transaction at a web site, which typically includes choosing 205 a shipping method.

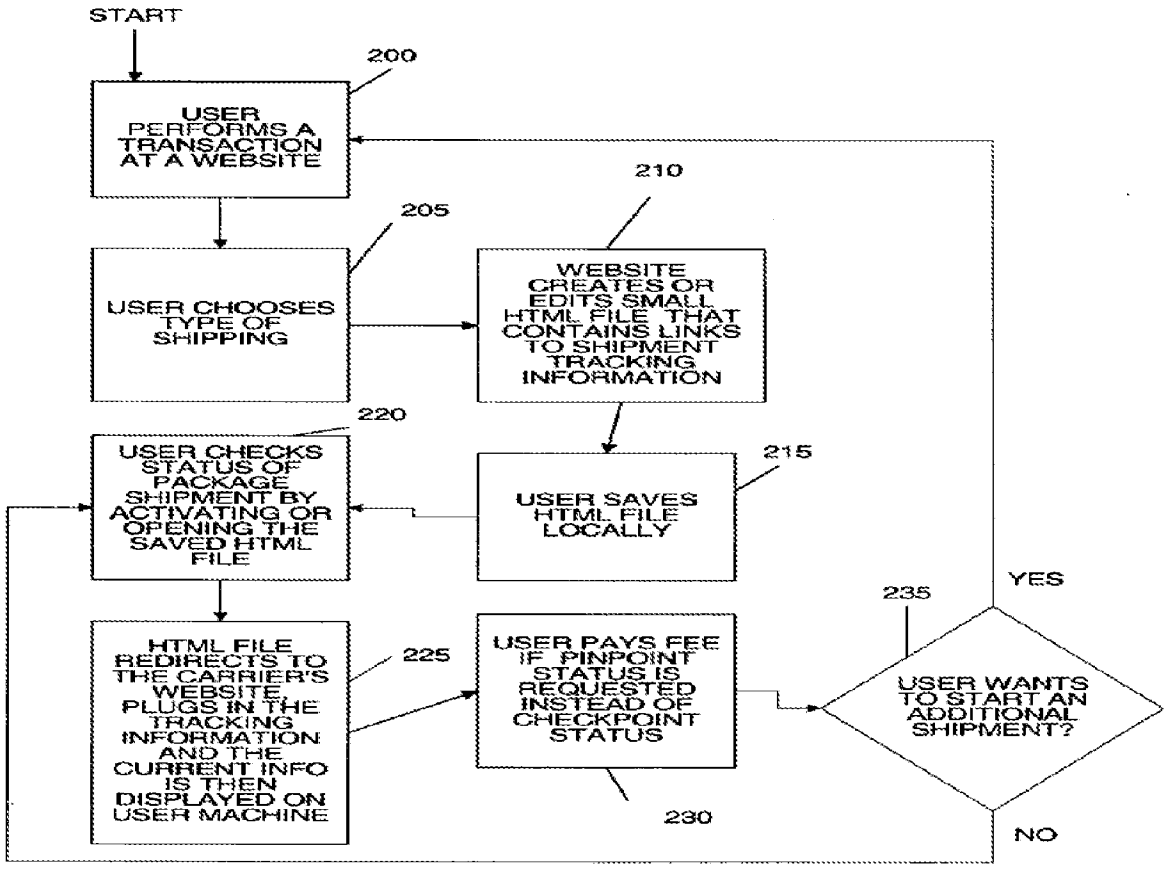

FIG. 2

Then the web site creates or edits 210 a small file that includes markup language, such as hypertext markup language (HTML) or extensible markup language (XML), so that the file will contain a link or links to shipment tracking information. This file is then saved locally 215 at a user device. Subsequently, the user checks the status

of package shipment by activating or opening 220 the saved html file. This file redirects the user's computer to the carrier's web site, where the tracking information is plugged in so that the current information is displayed 225 on the user machine. If the user has requested pinpoint status instead of checkpoint status, then the user will pay 230 a fee. The user is able to perform these steps iteratively, if the user decides 235 to start an additional shipment. See Specification at ¶ 0023 and FIG. 2.

Independent claim 1 is shown with illustrative annotated reference to the specification, reference numerals and figures:

> 1. A method for a user to find pinpoint status of a shipment being transported by a carrier, comprising the steps of (FIG. 1, ¶¶ 0020-22):
> clicking on a local shipment pinpoint symbol on a computer screen (121);
> connecting automatically to an internet or private network, if a connection is not already established (123, 125);
> then, in response to clicking on the shipment pinpoint symbol, sending automatically a shipping pinpoint status inquiry to the carrier via the internet or private network (127);
> requesting a pinpoint location of the shipment in response to the shipping pinpoint status inquiry (129); and
> receiving the requested pinpoint location of the shipment to the computer screen (131),
> wherein the pinpoint location identifies a position between checkpoints at each of which shipment presence is monitored regardless of user inquiries.

Independent claim 6 is shown with illustrative annotated reference to the specification, reference numerals and figures:

> 6. A method for providing a user a status indication associated with a shipment being transported by a carrier, comprising the steps of (FIG. 2, ¶ 0023):
> processing a user transaction at a web site (200);
> receiving a type of shipment selection (205);
> creating a file that includes markup language and that includes at least one link to shipment tracking information (210);
> providing the file to the user for storage locally at a user device (215);
> receiving a check status request from the file after the file is activated (220); and
> providing the status indication to the user (225).

Independent claim 13 is shown with illustrative annotated reference to the specification, reference numerals and figures:

> 13. A system for a user to obtain via internet or other network, a pinpoint status of a shipment being transported by a carrier, comprising (FIG. 3, ¶ 0024):
>
> a server computer for providing to a user computer a clickable shipment pinpoint symbol that is stored locally and when selected by the user triggers a shipping pinpoint inquiry to a carrier (300); and
>
> a shipping location tracker device, responsive to the shipping pinpoint inquiry, for providing the pinpoint status to the user computer via the internet or private network (322);
>
> wherein the pinpoint status identifies a position between two checkpoints at each of which shipment presence is monitored regardless of user inquiries.

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to Be Reviewed on Appeal

Whether claims 1-3 and 5-20 are patentable under 35 U.S.C. §102(b).

Whether claim 4 is patentable under 35 U.S.C. §103(a).

VII. Argument

As discussed in detail below, Appellant respectfully submits that the final rejection of claims 1-20 does not meet the threshold burden of presenting a prima facie case of unpatentability. Accordingly, Appellant is entitled to grant of those claims. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A Claims 1-3 and 5-20 are not Unpatentable under 35 U.S.C. § 102(b)

Claims 1-3 and 5-20 are in the case and stand finally rejected under 35 U.S.C. 102(b) as allegedly anticipated by US Patent Application Publication No. 2002/0032573 by Williams, et al. ("Williams '573").

Appellant respectfully disagrees with the rejection and urge its reversal for at least the reasons stated below.

To establish anticipation of the claims under § 102(e), the Examiner is required to show that every element or step of the claim is found in a single reference. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2D (BNA) 1618, 1624 (Fed. Cir. 1996).

Initially, in Williams '573, certain Figures (e.g., FIGs. 47-51) in the sections are redacted from the publication and thus not available as prior art. With regard to independent claims 1, 6 and 13, Williams '573 does not describe or suggest a client side symbol. For example, claim 1 recites "a local shipment pinpoint symbol on a computer screen." Claim 6 recites in part: "providing the file to the user for storage locally at a user device." Claim 13 recites in part: "a server computer for providing to a user computer a clickable shipment pinpoint symbol that is stored locally and when selected by the user triggers a shipping pinpoint inquiry to a carrier…"

Furthermore, in Williams '573, the cited embodiment in cited paragraphs including 0381-82 do not describe tracking information at all, but rather describe pricing information. In Williams '573, the user must log into a server side system and provide authentication before being presented a server side menu. In Williams '573, the server apparently maintains a server side log of shipments for a user and when a user selects a menu option on the server side system, a window of tracking status for all of the packages is shown and thus does not disclose the invention as presently claimed.

Independent Claim 1 and dependent claim 5 recite:

1. A method for a user to find pinpoint status of a shipment being transported by a carrier, comprising the steps of:
clicking on a local shipment pinpoint symbol on a computer screen;
connecting automatically to an internet or private network, if a connection is not already established;
then, in response to clicking on the shipment pinpoint symbol, sending automatically a shipping pinpoint status inquiry to the carrier via the internet or private network;
requesting a pinpoint location of the shipment in response to the shipping pinpoint status inquiry; and
receiving the requested pinpoint location of the shipment to the computer screen,
wherein the pinpoint location identifies a position between checkpoints at each of which shipment presence is monitored regardless of user inquiries.

5. The method of claim 1, wherein the position is separate from all of the checkpoints.

(emphasis added). Appellant respectfully submits that the Examiner has failed to establish that Williams '573 discloses each limitation of the claim and accordingly respectfully submit that the rejection should be reversed.

Appellant respectfully disagrees with the Examiner's interpretation of at least the term pinpoint as used herein and respectfully submit that the Examiner has not established a prima facie anticipation rejection as described herein. The Examiner has not shown at least the following elements in the one cited reference.

With regard to independent claim 1 and dependent claim 5 (also claims 7 and 13), the Examiner cites to Williams '573 at FIGs. 60 and 63 in section 3 of the Final Office Action to allegedly show pinpoint location data. Upon review of the cited figures and relevant text of the cited reference, it is clear that the reference does not teach or suggest pinpoint location information. The reference teaches only checkpoint information that is clearly distinguished in the specification of the instant application when describing pinpoint location data. Clearly it would not be reasonable to interpret pinpoint location data with checkpoint data when the specification in many places

clearly contrasts the two. See for example, specification at paragraph 0020. Reviewing Williams '573 at FIG. 63, it is clear that each line item is a different shipment and that only status information is provided – not pinpoint location data.

The instant application clearly distinguishes checkpoint status from pinpoint status in all of FIGs. 1-4 and associated description in the specification. In FIG. 3, two separate symbols are shown 315, 320. In FIG. 2, the user is charged more for pinpoint status when requested at step 230. See for example specification paragraph 0007 distinguishing pinpoint status from discrete checkpoints.

Regarding claim 2, the cited reference at page 117 does not describe including a tracking code of the shipment – and it could not because the link in question is used for pre-shipment shipping charge estimation.

Dependent claims 3 and 5 are patentable over the cited reference for at least the same reasons described above with reference to the associated independent claim and any intervening claims.

Independent Claim 6, and Dependent claims 8-9, 11 and 19-20 recite:

> 6. A method for providing a user a status indication associated with a shipment being transported by a carrier, comprising the steps of:
> processing a user transaction at a web site;
> receiving a type of shipment selection;
> creating a file that includes markup language and that includes at least one link to shipment tracking information;
> providing the file to the user for storage locally at a user device;
> receiving a check status request from the file after the file is activated; and
> providing the status indication to the user.
>
> 8. The method of claim 6, further comprising the steps of:
> replacing or modifying the file to create an improved file; and
> activating the improved file to check an additional status of an additional shipment being transported by an additional carrier.

9. The method of claim 8, wherein the step of replacing or modifying the file is implemented at least partly by a program stored in the user device.

11. The method of claim 8, wherein the step of replacing or modifying the file is implemented at least partly by the carrier or by the additional carrier.

19. The method of claim 9, further comprising:
the program stored in the user device displays a location message when a delivery vehicle is a first distance from a delivery location associated with the shipment.

20. The method of claim 9, further comprising:
the program stored in the user device is loaded as a background process after the status indication changes.

(emphasis added). Appellant respectfully submits that the Examiner has failed to establish that Williams '573 discloses each limitation of the claim and accordingly respectfully submit that the rejection should be reversed.

With regard to independent claim 6 and dependent claims 8-9, 11 and 19-20, the Examiner cites to Williams '573 at page 101, 110 and 120 in section 7 of the Final Office Action to allegedly show shipment selection data, but that activity cannot be associated with a shipment since it is pre-shipment activity in Williams '573.

Moreover, with regard to claim 11 and section 11 of the Final Office Action, the cited reference clearly describes the system servers 21s-21z modifying the file and not the carrier servers 23-2 through 27-2 (See Williams '573 at FIG. 3).

Furthermore, with regard to claims 19-20 and sections 15-16 of the Final Office Action, the cited reference Williams '573 at paragraph 0565 does not teach or suggest providing such a message "when a delivery vehicle is a first distance from a delivery location associated with the shipment." Moreover the cited reference does not teach or suggest any background status polling process.

Dependent claims 7, 10, 12 and 18 are patentable over the cited reference for at least the same reasons described above with reference to the associated independent claim and any intervening claims.

Independent Claim 13 recites:

> 13. A system for a user to obtain via internet or other network, a pinpoint status of a shipment being transported by a carrier, comprising;
> a server computer for providing to a user computer a clickable shipment pinpoint symbol that is stored locally and when selected by the user triggers a shipping pinpoint inquiry to a carrier; and
> a shipping location tracker device, responsive to the shipping pinpoint inquiry, for providing the pinpoint status to the user computer via the internet or private network;
> wherein the pinpoint status identifies a position between two checkpoints at each of which shipment presence is monitored regardless of user inquiries.

(emphasis added). Appellant respectfully submits that the Examiner has failed to establish that Williams '573 discloses each limitation of the claim and accordingly respectfully submit that the rejection should be reversed.

With regard to independent claim 13, Williams '573 does not describe or suggest a client side symbol. Claim 13 recites in part: "a server computer for providing to a user computer a clickable shipment pinpoint symbol that is stored locally and when selected by the user triggers a shipping pinpoint inquiry to a carrier…"

Regarding claim 14, the cited reference at page 117 does not describe including a tracking code of the shipment – and it could not because the link in question is used for pre-shipment shipping charge estimation.

Dependent claims 15-16 are patentable over the cited reference for at least the same reasons described above with reference to the associated independent claim and any intervening claims.

Thus, the Examiner has not established a prima facie anticipation rejection. Accordingly, Appellant respectfully submits that the rejection is clearly in error and should be reversed.

B Claim 4 is not Unpatentable under 35 U.S.C. § 103(a)

Claim 4 is in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by US Patent Application Publication No. 2002/0032573 by Williams, et al. ("Williams '573") in view of US Patent No. 6,965,868 to Bednarek ("Bednarek '868").

Appellant respectfully disagrees with the rejection and urge its reversal for at least the reasons stated below.

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___ , 127 S.Ct. 1727, 1735 (2007) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (quoting Kahn, 441 F.3d at 988)). *See also*, *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007) (To avoid improper use of hindsight, the Examiner must articulate "a reason that would have prompted a

person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. (quoting *KSR*, 127 S. Ct. at 1731)).

See also, In re Kahn, 441 F.3d 977 (Fed. Cir. 2006)(Most inventions arise from a combination of old elements and each element may often be found in the prior art. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole).

Dependent claim 4 recites:

> 4. The method of claim 1, wherein if the step of providing the pinpoint shipping status information to the computer screen is performed later than a certain time after the step of sending automatically the shipping pinpoint inquiry, due to a delay, then a user of the computer screen is compensated for the delay, and if the step of providing the pinpoint shipping status information to the computer screen is not performed later than a certain time after the step of sending automatically the shipping pinpoint inquiry, due to a delay, then the user of the computer screen is not compensated.

Initially, claim 4 is patentable over the cited references for at least the reasons described herein with reference to the associated independent claim and any intervening claims.

Here, the cited references are not properly combined as there is no reason one of skill in the art would look to Bednarek '868 to modify Williams '573. Moreover, even if properly combined, the cited references do not describe of fairly suggest each element. Bednarek '868 describes only redemption rates in a point based loyalty system – nothing to do with providing a refund for a shipping information service delay.

Thus, the Examiner has not established a prima facie obviousness rejection. Accordingly, Appellant respectfully submits that the rejection is clearly in error and should be reversed.

IX. Conclusion

In Conclusion, Appellant respectfully submits that the final rejection of claims 1-20 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

/George M. Macdonald/

George M. Macdonald
Reg. No. 39,284
Attorney for Appellant
Telephone (203) 924-3180

PITNEY BOWES INC.
Intellectual Property and Technology Law Department
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484-8000

VIII – CLAIMS APPENDIX
APPENDIX A

1. A method for a user to find pinpoint status of a shipment being transported by a carrier, comprising the steps of:

clicking on a local shipment pinpoint symbol on a computer screen;

connecting automatically to an internet or private network, if a connection is not already established;

then, in response to clicking on the shipment pinpoint symbol, sending automatically a shipping pinpoint status inquiry to the carrier via the internet or private network;

requesting a pinpoint location of the shipment in response to the shipping pinpoint status inquiry; and

receiving the requested pinpoint location of the shipment to the computer screen,

wherein the pinpoint location identifies a position between checkpoints at each of which shipment presence is monitored regardless of user inquiries.

2. The method of claim 1, wherein the shipment pinpoint symbol is an icon of a file, in a markup language, including a tracking code of the shipment.

3. The method of claim 1, wherein the shipment pinpoint symbol is provided to the computer screen in conjunction with a shipment checkpoint symbol, and

wherein the shipment checkpoint symbol is for obtaining information as to the presence of at least one of the checkpoints.

4. The method of claim 1, wherein if the step of providing the pinpoint shipping status information to the computer screen is performed later than a certain time after the step of sending automatically the shipping pinpoint inquiry, due to a delay, then a user of the computer screen is compensated for the delay, and if the step of providing the pinpoint shipping status information to the computer screen is not performed later than a certain time after the step of sending automatically the shipping pinpoint inquiry, due to a delay, then the user of the computer screen is not compensated.

5. The method of claim 1, wherein the position is separate from all of the checkpoints.

6. A method for providing a user a status indication associated with a shipment being transported by a carrier, comprising the steps of:

processing a user transaction at a web site;

receiving a type of shipment selection;

creating a file that includes markup language and that includes at least one link to shipment tracking information;

providing the file to the user for storage locally at a user device;

receiving a check status request from the file after the file is activated; and

providing the status indication to the user.

7. The method of claim 6, wherein the status indication indicates a position between checkpoints at each of which shipment presence is monitored regardless of user inquiries, and wherein the position is separate from all the checkpoints.

8. The method of claim 6, further comprising the steps of:

replacing or modifying the file to create an improved file; and

activating the improved file to check an additional status of an additional shipment being transported by an additional carrier.

9. The method of claim 8, wherein the step of replacing or modifying the file is implemented at least partly by a program stored in the user device.

10. The method of claim 8, wherein the step of replacing or modifying the file is implemented at least partly by a third party.

11. The method of claim 8, wherein the step of replacing or modifying the file is implemented at least partly by the carrier or by the additional carrier.

12. The method of claim 6, wherein the shipment tracking information is for a plurality of shipments being transported by a plurality of carriers.

13. A system for a user to obtain via internet or other network, a pinpoint status of a shipment being transported by a carrier, comprising;

a server computer for providing to a user computer a clickable shipment pinpoint symbol that is stored locally and when selected by the user triggers a shipping pinpoint inquiry to a carrier; and

a shipping location tracker device, responsive to the shipping pinpoint inquiry, for providing the pinpoint status to the user computer via the internet or private network;

wherein the pinpoint status identifies a position between two checkpoints at each of which shipment presence is monitored regardless of user inquiries.

14. The system of claim 13, wherein the shipment pinpoint symbol is an icon of a file, in a markup language, including a tracking code of the shipment.

15. The system of claim 13, wherein the shipment pinpoint symbol is provided to the computer screen in conjunction with a shipment checkpoint symbol, and

wherein the shipment checkpoint symbol is for obtaining information as to the presence of at least one of the checkpoints.

16. The system of claim 13, wherein the position is separate from all of the checkpoints.

17. The method of claim 9, further comprising:

the program stored in the user device automatically polls additional check status requests after the status indication changes.

18. The method of claim 17, wherein:

the status indication change indicates the shipment is out for delivery.

19. The method of claim 9, further comprising:

the program stored in the user device displays a location message when a delivery vehicle is a first distance from a delivery location associated with the shipment.

20. The method of claim 9, further comprising:

the program stored in the user device is loaded as a background process after the status indication changes.

Appendix IX – Evidence Appendix

None

Appendix X – Related Proceedings Appendix

None